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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,493	01/26/2004	Edward Hosung Park	03-0054	3710

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FREUDENBERG-NOK GENERAL PARTNERSHIP
LEGAL DEPARTMENT
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

NOTIFICATION DATE	DELIVERY MODE
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07/13/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

cyr@fngp.com
rrw@fngp.com
fngp@hdp.com

Office Action Summary

Application No.

10/765,493

Applicant(s)

PARK, EDWARD HOSUNG

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the species of claims 1-18 in the reply filed on 21 March 2007 is acknowledged. The traversal is on the ground(s) that:

1) "The Examiner has not....provided any rationale for why these embodiments are distinct, other than a statement that the claims recite different steps for each method. Applicant submits that this is not a sufficient rationale for restriction, insofar as there is no discussion or support for how or why those differences have patentable significance."

2) "Applicant further notes that Claim 1 (Group I) subsumes the claims of Group 3, insofar as each step of Claim 26 falls within steps of Claim 1."

3) "(T)he Examiner has not provided a rationale for why searching all of the claims would create an undue burden."

This is not found persuasive because

1) the different steps of each process will provide results that differ in characteristics and effect. For example, the Species I claims do not require a ring opening or condensation polymerization as recited for the Species II claims.

2) With respect to the Species 3 claims, the composition may be thoroughly homogeneous, which is not apparent from the recitations in either claim 1 or claim 19.

3) Applicant fails to understand that each added step requires further consideration. Three processes containing different directives would certainly create a burdensome search for the Office.

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The requirement is still deemed proper and is therefore made FINAL.

In future correspondence, applicant is required to respond to restrictions or other objections properly, or the response will be considered non-responsive. Applicant failed to list the claims that the elected species read on. The claims of the election are, thus, claims 1, 2, 6-9, 11-14 and 16-18.

Claims 3-5, 10, 15 and 19-34 are withdrawn from consideration as being drawn to species non-elected with traverse.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

ClaimS 1, 2, 6-9, 11-14 and 16-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-52 and 71-79 of copending Application No. 10/620,213 (US 2005/0014900) Park, cited

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by applicant. Although the conflicting claims are not identical, they are not patentably distinct from each other because the document shows the required method of forming a mixture by combining an uncured or partially cured elastomeric material, a curing agent and a thermoplastic material, with subsequent application of heat and mechanical energy. The elastomer may be a fluororubber, including those recited herein. The thermoplastic may comprise a polyester. The method steps are essentially identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9, 11, 12 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Goebel et al (EP 0 432 911 A1), cited by applicant.

Note the Abstract and page 3 (lines 50-54) for the basic concept. Further, note page 4 (lines 19-37) for the fluoroelastomers employed, including those of the instant claims. Note the inclusion of cure site monomers at page 3 (lines 52-57). The paragraph bridging page 4 to page 5 shows the use of peroxide and polyhydroxy compound curing agents. Note page 7 (line 38) to page 8 (line 39) for the use of polyester resins, including the polybutylene terephthalate employed herein. The process is taught essentially at page 9, final paragraph.

Claims 1, 2, 6, 8, 9, 11-14 and 16-18 are rejected under 35 U.S.C. 102(b) as anticipated by Takeyama et al (US 6,079,465), newly cited.

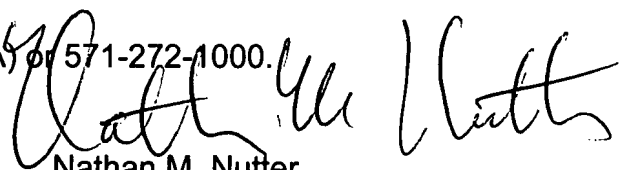
The reference to Takeyama et al shows the production of a rubber composition that may comprise fluororubbers, including those recited herein, at the paragraph bridging column 6 to column 7, with a thermoplastic that may be a polyester, including polybutylene terephthalate at the paragraph bridging column 5 to column 6, with a curing agent that may be a peroxide or a polyhydroxy phenol resin, at column 10 (lines 40-61). The process steps are set out at column 10 (lines 3-34) and may be continuous (twin screw extruder) or batch (kneader, Banbury mixer, etc.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

5 July 2007